8-29-05 CW 1642

Attorney's Docket No.: 14875-085001 / C2-101PCT-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Yoshihiro Sowa et al. Art Unit : 1642
Serial No. : 09/937,162 Examiner : Laura B. Goddard, Ph.D.
Filed : September 21, 2001
Title : METHOD FOR SCREENING ANTICANCER AGENT

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Commissioner for Patents
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RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the action mailed June 28, 2005, applicants elect the invention of Group 1 with traverse.

The Examiner divides pending claims 6-24 into Groups 1-17, reasoning as follows.

> The inventions of Groups 1-[17] are not considered to be so linked as to form a single general inventive concept because all of the Groups are drawn to methods which are distinct because each method uses different reagents or has different objectives (Restriction Requirement, page 6, second full paragraph).

The Examiner has not properly applied the PCT rules to her reasoning. PCT Rule 13.1 stipulates the requirement of unity of invention, stating that the international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. Whether the requirement of unity of invention is satisfied is determined based on criteria defined in Rule 13.2. According to this rule, the requirement of unity of invention referred to in Rule 13.1 is satisfied when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" is defined in Rule 13.2 as those technical features that define a contribution that each of the inventions, considered as a whole, makes over the prior art.

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The Examiner has failed to note that all of claims 6-20 by definition share the special technical features of claim 6, since all of claims 7-20 depend from claim 6. Thus, all of these claims have the same objective (identifying an agent having cellular anti-proliferation activity) and use the reagents as defined in claim 6. The fact that various dependent claims provide further details regarding the reagents used in the methods is irrelevant to the question of unity of invention.

Furthermore, according to the MPEP, Administrative Instructions Under the PCT, Annex B, Part 1 (c), unity of invention is considered in the first place only in relation to the independent claims in an international application, not the dependent claims. If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention. Contrary to the rule, the Examiner divides the inventions of claims 6-20 based on features defined only in the dependent claims.

Claims 21-24 are composition claims. Claim 21 is drawn to an anticancer agent comprising a compound that increases the transcriptional activity mediated by Sp3. Since this claim involves Sp3, it shares a special technical feature with all of claims 6-20. Claims 22-24 depend from method claims 6, 8, and 9, respectively, and cover agents identified by the respective screening methods. They therefore also share a special technical feature with the method claims.

In summary, the Examiner has not correctly considered unity of invention under the PCT rule. Applicants respectfully request that claims 6-24 be examined together in this application.

Enclosed is a $120 check for the Petition for Extension of Time fee. Please apply any other charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 14875-085001.

Respectfully submitted,

Date: Aug 26, 2005

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